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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,298	02/26/2002	Yen-Liang Kuan	MR1115-382	2788
4586	7590	05/10/2004	EXAMINER	
ROSENBERG, KLEIN & LEE 3458 ELLICOTT CENTER DRIVE-SUITE 101 ELLICOTT CITY, MD 21043			WARD, AARON S	
			ART UNIT	PAPER NUMBER
			2675	

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,298

Applicant(s)

KUAN, YEN-LIANG

Examiner

Aaron S. Ward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hikasa, JP 10124250 A, in view of Zenz, Sr., U.S. Patent No. 5,841,425.

As to claim 1, Hikasa teaches in Figs. 1A and 1B a power saving device in a wireless mouse 3 with a signal emitter 7, a battery 6, and at least one sensor 3 connected to the battery 6 and the signal emitter 7 (via control means 5, see paragraph 11 which discloses "control means 5 supply cell 6 power supply to... the transmitting means 7"). The sensor 3 is triggered when a user holds the mouse, to connect the battery (see paragraph 11), and the supply power is stopped if the hand separates from the mouse (see paragraph 12).

Hikasa does not disclose that the wireless mouse housing has a scroll wheel, or that the housing has a window disposed on its upper surface.

Regarding the scroll wheel, it was notoriously well-known in the art at the time of the invention that mice have scroll wheels on their front.

Regarding the housing having a window disposed on its upper surface, Zenz, Sr. discloses in Figures 3A and 3B a mouse 30 having sensors 42, 44 disposed in the upper surface of the mouse housing. The sensors can be optical driver/receivers using infrared or visible light

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(column 4, line 47). Zenz, Sr. discloses in column 8, line 2-3 that a lens is used. A lens functions as a window.

It would be obvious for one of ordinary skill in the art at the time of invention to incorporate the window as taught by Zenz, Sr. into the mouse housing disclosed by Hikasa, to accommodate an optical driver/receiver for detecting a hand because a window allows optical signals to pass.

One of ordinary skill in the art would be motivated to make such a combination because Hikasa discloses the need for detection of a hand on the mouse, and Zenz, Sr. discloses that covering of an optical driver/receiver (sensor) results in detection or sensing of a hand (see column 7, lines 60-62). Furthermore, use of an optical sensor as taught by Zenz, Sr. would eliminate the potential for electrical interference in the capacitive sensor taught by Hikasa.

As to claim 2, as explained above, the combined teaching of Hikasa and Zenz, Sr. discloses the power saving device of claim 1 with an emitter 74 and receiver 76 forming the sensor 42 (see Figures 6A and 6B of Zenz, Sr.). The signal is sent from the emitter 74 and received by the receiver 76. The received signal would inherently be the same as the sent signal because the same signal would be reflected by the finger to the receiver 76.

### ***Response to Arguments***

3. Applicant's arguments filed March 19, 2004 have been fully considered but they are not persuasive. Applicant amended the claims to recite that the mouse sensor is triggered when a user's hand is positioned above and external to the mouse, and Applicant indicated that neither Hikasa nor Zenz teach passing the hand or other object above the mouse to activate the mouse.

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However, Webster's Revised Unabridged Dictionary, © 1996, 1998 MICRA, Inc. defines above as: "1. In or to a higher place; higher than; on or over the upper surface; over; -- opposed to below or beneath" [emphasis added]. Clearly, the Hikasa and Zenz reference teach positioning the hand above and external to the mouse because the hand is "on or over the upper surface; over."

The Applicant indicated that it would not be obvious to combine the references because the Zenz sensors are used for determination of handedness and not mouse actuation from a powered-down state. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, although the Zenz sensors aren't specifically used for mouse actuation from a powered-down state, Hikasa discloses the need for detection of a hand on the mouse, and Zenz, Sr. discloses that covering of an optical driver/receiver (sensor) results in detection or sensing of a hand (see column 7, lines 60-62). Furthermore, use of an optical sensor as taught by Zenz, Sr. would eliminate the potential for electrical interference in the capacitive sensor taught by Hikasa.

### ***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron S. Ward whose telephone number is (703) 305-8992. The examiner can normally be reached on Monday - Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven J. Saras can be reached on (703) 305-9720. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ASW

  
DENNIS-DOON CHOW  
PRIMARY EXAMINER